

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Perry R. CZIMMEK

Application No.: 09/813,912

Filed: March 22, 2001

For: Method of Control for a Self-Sensing Magnetostrictive Actuator



) Confirmation No.: 4677

) Group Art Unit: 2834

) Examiner: Judson Jones

Mail Stop Issue Fee

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE
PURSUANT TO 37 C.F.R. § 1.104 (e)

Sir:

In response to the Statement of Reasons for Allowance in the Notice of Allowability dated October 20, 2003, the following comments are submitted.

Applicants do not believe that the Statement of Reasons for Allowance in this case is warranted/proper under 37 C.F.R. § 1.104(e) and M.P.E.P 1302.14 because the Reasons for Allowance states that the claims are allowed based on specific features recited in claim 1. Furthermore, the Reason for Allowance states that claim 1 is also allowable because there is no motivation to apply U.S. Patent No. 5,698,911 of Dunfield et al with Hasselmark. Applicant respectfully asserts that, not only is there a lack of motivation to combine Dunfield with Hasselmark (as confirmed by the Examiner), Dunfield is inappropriate to combine with Hasselmark because Dunfield shows and describes a moving coil whereas, in contrast, Hasselmark involves, in part, the feedback control of a magnetostrictive member.

While Applicant believes that the claims are allowable and patentably distinguish over the prior art, Applicants do not acquiesce that patentability resides in each feature, exactly as expressed in only claim 1, nor that each and every feature in claim 1 is required for patentability. And, Applicant submits that patentability is based on the claimed invention as a whole, as recited in claims 1, 7, 10, and 18, and not solely on one or more particular features recited in the claim 1.

Respectfully submitted,

Date: January 20, 2004

By:

Khoi Q. Ta
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TRANSMITTAL OF REPLACEMENT DRAWINGS

Applicants respectfully submit a replacement drawing sheet containing four sheets of four figures pursuant to the Examiner's Approval of the Request for Approval of Drawing Revision filed December 23, 2002. Applicants respectfully assert that these changes introduce no new matter in that they conform to the specification and/or drawings as originally filed, pursuant to 37 C.F.R. § 1.81(d).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: January 20, 2004

By: _____

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